

--12--

**REMARKS**

Claims 1-31 are pending in this patent application. By this amendment, claims 1 and 31 are amended for clarity and readability and claims 2 and 20 are amended to address minor matters of form. Applicants do not believe that the amendments are narrowing. No new matter has been added. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

***35 U.S.C. 103 Rejections:***

Claims 1-2, 14-16, 21-24 and 31 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Austrian reference 405,560 in view of German reference 29703962 and in view of any one of Scarlett, U.S. Patent No. 5,323,584, Keller et al., U.S. Patent No. 4,195,462, or Turner, U.S. Patent No. 5,899,251. Applicants respectfully traverse this rejection.

In order for a prior art reference or combination of references to render a claim obvious, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1 recites "a configuration for combining flat structural components" in which "a pre-applied adhesive layer, or a pre-applied layer of a substance which activates adhesive, is present on a groove at least in the area of its divergent sides or on [a] tongue at least in the area

--13--

of its divergent wedge-shaped area, or on both areas.” Claim 31 recites “a pre-applied adhesive layer or pre-applied substance which activates adhesive on [a] groove at least in the area of the divergent sides or on [a] tongue at least in the area of the divergent wedge-shaped area, or on both areas.”

The Examiner’s position is that the Austrian reference discloses a substrate having the structure recited in the claims and that it would have been obvious to “have provided the floor tile assembly of Austrian ’560 with adhesive between and within the tongue and groove joints,” in view of the secondary references. Moreover, on page 4 of the Office Action, the Examiner asserts that the term “pre-applied” refers to a process, rather than a structural limitation, and further asserts that the claim does not differentiate structurally from the prior art. The Examiner continues by asserting that “the product of Australian ’560 [*sic*; Austrian], as modified, and, the final product of the instant invention (i.e., structural components with a glued interlocking tongue and groove joint) [are] one and the same.” Applicants respectfully disagree with the Examiner’s position and assertions.

First, with respect to the Examiner’s assertions regarding the nature of the claim term “pre-applied,” Applicants submit that that term denotes a structural feature. As was noted above, claims 1 and 31 now recite, *inter alia*, that “[a] pre-applied adhesive layer...is present on a groove[.]” Without intervention or action by the user, as supplied to the user, the adhesive layer (or adhesive-activating substance) is present. While Applicants do not disclaim their right to pursue method or process claims on a method of manufacturing the claimed configuration, the features of claims 1 and 31 are clearly structural in nature, i.e., they represent a tangible collection of features present in the recited structures.

--14--

With the above in mind, and before delving once again into the tripartite test as to whether a reference or combination of references renders Applicants' claims obvious, Applicants respectfully object to the Examiner's claim interpretation, and respectfully submit that the Examiner is impermissibly reducing the features recited in the claims to a gist.

In particular, Applicants note the Examiner's statements and assertions as to what is and is not recited in Applicants' claims. For example, the Applicants note the Examiner's assertion with respect to the "final product of the instant invention." Applicants submit that "the final product of the instant invention" has no bearing on the obviousness inquiry and, furthermore, that this statement represents the improper reduction to a gist of the features that Applicants actually are claiming.

In fact, as is clear from at least claims 1 and 31, Applicants are not claiming any sort of structure with a glued joint. Rather, Applicants are claiming "a configuration for combining flat structural components of relatively low thickness" having certain specific structural features. Nowhere in claims 1 or 31 does the phrase "glued joint" appear.

Moreover, Applicants note that the Office Actions to this point are bereft of discussion of the specific features recited in the dependent claims, despite Applicants' specific arguments with those claims and specific comments that the features are not found in the prior art references. (See, for example, the Brief of Appellants filed on March 13, 2003 at pages 11-13.) As stated in MPEP § 707.07(f), "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Therefore, as a matter of procedure, the rejection is improper and should be withdrawn. Clearly,

--15--

piecemeal response to Applicants' arguments does not advance the prosecution of this application.

Given the Examiner's comments as to the "final product of the instant invention" and the lack of specific discussion as to where the features of the dependent and independent claims may be found in the prior art, Applicants can draw no other conclusion than that the Examiner is improperly reducing the invention to a gist.

Finally, with respect to the particular references cited by the Examiner, Applicants respectfully submit that they do not render independent claims 1 and 31, or the claims that depend from them, obvious. The Austrian '560 reference discloses glueless, interlocking panels. The German '962 reference discloses factory-applied adhesive layers as used on conventional glued panels, and does not suggest the use of pre-applied adhesive layers on interlocking panels. Turner et al. and Keller are completely silent as to a pre-applied adhesive layer; Scarlett suggests only that adhesive may be used to bond together the pieces that comprise the I-beam disclosed by the reference.

Taken collectively, the cited references do not disclose or suggest a pre-applied adhesive layer or a pre-applied layer of a substance that activates an adhesive in the specific structures recited in independent claims 1 and 31. Accordingly, the cited combination of references does not render obvious independent claims 1 and 31, or the claims that depend from them.

Therefore, Applicants respectfully request that the rejection be withdrawn.

Claims 1-31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Austrian reference 405,560 in view of German reference 29703962 and any one of Scarlett, U.S. Patent No. 5,323,584, Keller et al., U.S. Patent No. 4,195,462, or Turner, U.S. Patent No.

--16--

5,899,251, and further in view of Roesch, U.S. Patent No. 6,004,417. Applicants respectfully traverse this rejection.

The Examiner's position in setting forth this rejection is stated to be the same as that in setting forth the previous rejection under 35 U.S.C. § 103(a). The Examiner further asserts that "Roesch et al...teach utilization and advantages of various 'two component' adhesives including microencapsulatable solvent adhesives."

First and foremost, Applicants respectfully disagree with the blanket rejection of all of claims 1-31 over the cited combination of references. Apparently, judging by the previous rejection, the addition of the Roesch et al. reference to the previously cited combination is asserted to render claims 3-13, 17-21, and 25-30 obvious. If so, then only those claims should be included in the rejection, so that Applicants are not faced with the undue burden of responding to cumulative rejections that add nothing of substance or specificity to the prosecutorial record.

Notwithstanding Applicant's position on the rejection itself, Applicants submit that claims 1-31 are not obvious over the cited combination of references for at least the same reasons given above with respect to the previous rejection under 35 U.S.C. § 103(a). Moreover, with respect to the specific teachings of the Roesch et al. reference, Applicants respectfully submit that it does not render all of the claims obvious, either alone or in combination with the other cited references. In general, Applicants submit that Roesch et al. discloses adhesive compositions specifically for bonding poly(vinyl chloride) (PVC), chlorinated poly(vinyl chloride) (CPVC) and acrylonitrile-butadiene-styrene (ABS) (i.e., plastic) pipes. Applicants note that these are not necessarily the same types of adhesives that would be used in configurations according to claims 1 and 31.

--17--

For example, claim 5 recites a dispersion glue “comprising a fast-binding and mounting glue on a polyvinyl acetate base.” However, Roesch et al. discloses only a PVC-vinyl acetate co-polymer. Claim 8 recites a hardener varnish with an “organic peroxide as its base” and a resin “which has a methyl acrylate” base. Neither of those components is disclosed in Roesch et al. Clearly, the Examiner’s blanket assertions with respect to the Roesch et al. reference are unwarranted.

Furthermore, regardless of the particular disclosures of the Roesch et al. reference, Applicants submit that it does not remedy the “defects” of the other cited references that were noted above. More particularly, Roesch et al. does not disclose or suggest a pre-applied adhesive layer or a pre-applied layer of a substance that activates an adhesive in the type of structures recited in independent claims 1 and 31. Accordingly, Applicants respectfully submit that the cited combination of references does not render claims 1-31 obvious, and respectfully request that the rejection be withdrawn.

--18--

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that all the claims are allowable over the cited references and that the application itself is in condition for allowance. The examiner is respectfully requested to pass this application to issue. The examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for an extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 23-1951.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a long horizontal flourish extending to the right.

Andrew M. Calderon  
Registration No. 38,093

McGuireWoods, LLP  
Suite 1800  
1750 Tysons Blvd.  
McLean, VA 22102  
(703) 712-5426